

REMARKS

Claims 1, 5, 6 and 13-19 are all the claims pending in the application. Claims 1 and 19 are each amended to correct a minor informality by adding a period at the end of the sentence. No new matter is presented.

I. PTO/SB/08 Forms

Applicants thank the Examiner for returning initialed copies of the PTO/SB/08 Forms submitted with the Information Disclosure Statements filed on July 12, 2005, August 11, 2005 and August 12, 2005.

Applicants note that the Examiner has not yet returned an initialed copy of the Corrected PTO/SB/08 Forms submitted with the Information Disclosure Statement on September 14, 2005 or the PTO/SB/08 Form submitted with the Information Disclosure Statement filed on October 26, 2005. Applicants respectfully request that the Examiner return initialed copies of these PTO/SB/08 Forms with the next Action.

II. Response to Claim Objection

Claims 1, 5-9 and 13-19 are objected to because claim 1 lacks a period at the end of the sentence. Claim 1 is amended herein to correct this informality. Accordingly, Applicants respectfully request withdrawal of the objection.

III. Response to Claim Rejection – 35 U.S.C. § 112, 1st Paragraph

Claims 1, 5-9 and 13-19 are rejected under 35 U.S.C. § 112, 1st paragraph as allegedly being non-enabled for any combination of the chlorine substituted sulfonium salt anion with any counterions Z¹¹⁻ as claimed.

Applicants respectfully traverse the rejection based on the following.

In making a determination of enablement, the proper inquiry is whether one of ordinary skill in the art would be able to use the claimed invention without undue experimentation. There are several factors which must be weighed and considered to determine whether any necessary experimentation can be considered as undue: (1) the breadth of the claims; (2) the nature of the invention; (3) the state of the prior art; (4) the level of one of ordinary skill in the art; (5) the level of predictability in the art; (6) the amount of direction provided by the inventor; (7) the existence of working examples; and (8) the quantity of experimentation needed to make and use the invention based upon the disclosure. See MPEP § 2164.01(a).

Applicants are not required to provide a specific example of every operable species within the scope of the claims. See MPEP § 2164.03. Applicants' burden under 35 U.S.C. §112, first paragraph, is to provide an enabling disclosure which teaches one skilled in the art to make and use the scope of the claimed invention without undue experimentation. Thus, even if the claims encompass inoperative species, the claims comply with the enablement requirement as long as undue experimentation is not necessary to determine which species would or would not work.

In addition to the description and definitions provided, Applicants have provided representative examples within the scope of the claims. Representative examples together with a statement applicable to the genus as a whole is ordinarily sufficient if one of ordinary skill in the art would expect the claimed genus to be used in that manner without undue experimentation. In this regard and in view of the state of the art, nature of the art and the level of skill of one of ordinary skill in the art, the specification provides sufficient description,

guidance and working examples for one of ordinary skill in the art to be able to practice the full scope of the present invention. Thus, it would not be undue experimentation for one of ordinary skill in the art to practice the claimed invention based on the disclosure in the present specification.

Accordingly, Applicants respectfully request withdrawal of the rejection.

III. Response to Claim Rejection – 35 U.S.C. § 112, 2nd Paragraph

Claims 1, 5-9 and 13-19 are rejected under 35 U.S.C. § 112, 2nd paragraph, as allegedly being indefinite because the counter “n” in formula M-14 – M-17 in independent claim 1 is not defined.

Applicants respectfully traverse the rejection. Applicants submit that one of ordinary skill in the art would readily understand that the counter “n” in formula M-14 to M-17 in independent claim 1 simply means any number of repeating units. In support thereof, Applicants submit a copy of a Material Safety Data Sheet for the commercial products which corresponds to the compounds of M-14 to M-17 as evidence on the following grounds.

As described in the specification of the present application (page 6, lines 17-24), “the polymerizable compound having a urethane skeleton is an addition-polymerizable compound having at least one urethane linkage and at least one prepolymer, which includes dimers, trimers and oligomers, as well as mixtures and copolymers thereof. The polymerizable compounds have a problem in that it is difficult to have the number of repeating units therein remain constant. Further, the oligomers shown in the data sheet for the commercial products have a polymerization degree of 100 or less, and the total amount of the addition-polymerizable

compounds (i.e., the addition-polymerizable compounds having a urethane skeleton and the optionally used other addition-polymerizable compounds) is limited within a range of preferably 5 to 80% by mass, and more preferably 25 to 75% by mass, based on nonvolatile components in the photosensitive layer (page 18, lines 5-9). Therefore, one skilled in the art can understand and determine the polymerization degree of the compounds of M-14 to M-17 from the standard data of the commercial products without presenting the definition of "n" in formula M-14 to M-17.

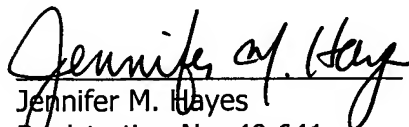
Accordingly, Applicants respectfully request withdrawal of the rejection.

IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


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Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: February 28, 2006



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474-1

Material Safety Data Sheet

1. Company Identification

Company: Shin-Nakamura Chemical Co., Ltd.

Address: 687, Arimoto, Wakayama

Division: Quality control

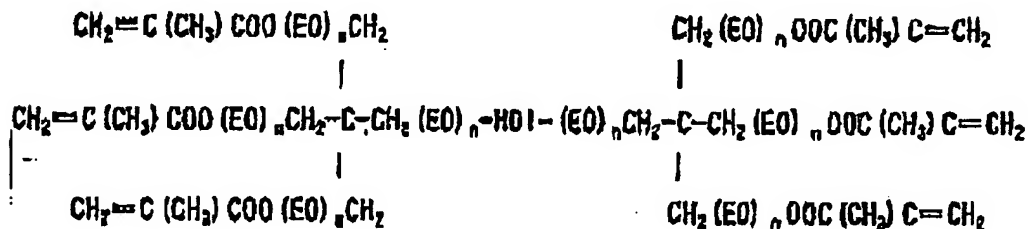
Tel: (073)423-3256 Fax: (073) 433-4665

Reference No. 474

Date (revised): May 26, 2005

Chemical Product: NK OLIGO U-6ELH

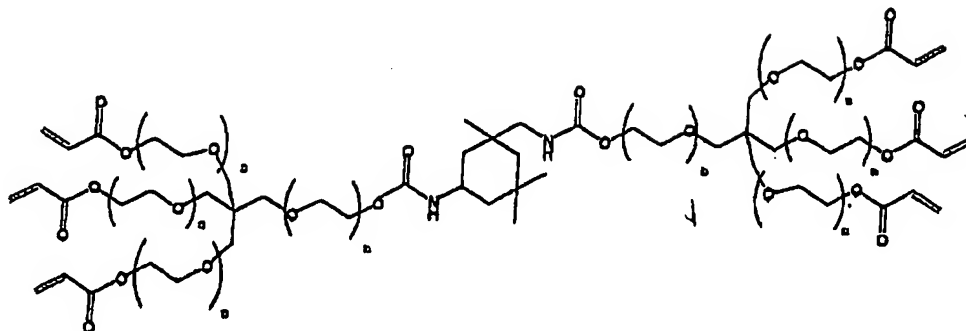
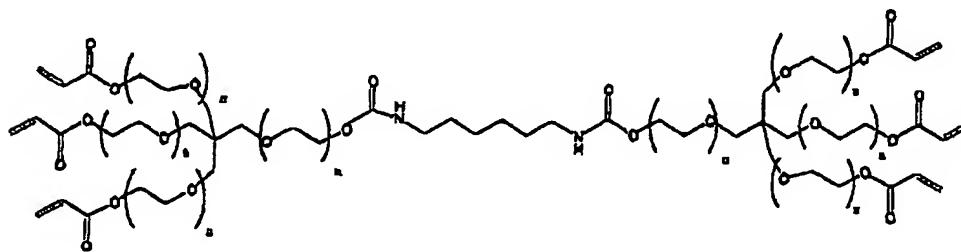
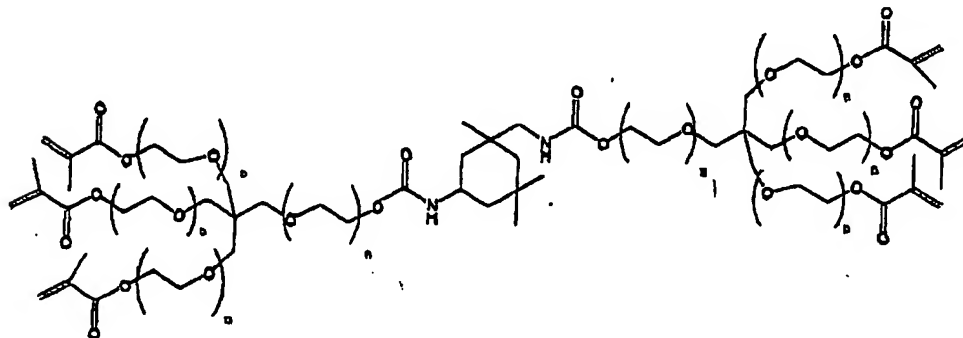
2. Identity of materials

Chemical name: Urethanacrylate**Identification of single product and mixture:** single**Ingredients and amount:** about 100% of the above ingredient**Formula or Structure:** (M14)

Registered Number of certified reference material: Registered No. under Chemical Substances Control Law 7-822 (the Number under MSDS is the same as that under CSCL)

CAS No.: -**International classification and UN No.:** -

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**Structure of main ingredients for NK OLIGO****1. UA-6ELP (M17)****2. UA-6ELH(M15)****3. U-6ELP(M16)****BEST AVAILABLE COPY**

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474-1

製品安全データシート

1. 製造者情報

会社名 新中村化学工業株式会社
 住所 和歌山県和歌山市有本687
 担当部門 品質管理部
 電話番号 (073) 423-3256 F A X 番号 (073) 433-4665

整理番号 No. 474

作成改訂 平成 17 年 5 月 26 日

製品名 NK オリゴ U-6ELH

2. 物質の特定

化学名	ウレタンアクリレート	
単一製品・混合物の区別	単一	
成分及び含有量	上記成分約 100%	
化学式又は構造式	$ \begin{array}{c} \text{CH}_2=\text{C}(\text{CH}_3)\text{COO}(\text{EO})_n\text{CH}_2 \\ \\ \text{CH}_2=\text{C}(\text{CH}_3)\text{COO}(\text{EO})_n\text{CH}_2-\text{C}-\text{CH}_2(\text{EO})_m\text{HDI}-(\text{EO})_n\text{CH}_2-\text{C}-\text{CH}_2(\text{EO})_n\text{OOC}(\text{CH}_3)\text{C}=\text{CH}_2 \\ \\ \text{CH}_2=\text{C}(\text{CH}_3)\text{COO}(\text{EO})_n\text{CH}_2 \\ \\ \text{CH}_2(\text{EO})_n\text{OOC}(\text{CH}_3)\text{C}=\text{CH}_2 \end{array} $	
官報公示整理番号	化審法 7-822	安衛法 同左
CAS No.	—	
国連分類及び国連番号	—	

M-14

3. 危険有害性の分類

分類の名称	該当せず。
危険性	引火性あり、火気厳禁。
有害性	皮膚に付着すると、かぶれる恐れあり。
環境影響	—

- 1 -

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大船印刷

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2006年 1月24日 16時24分

浮上

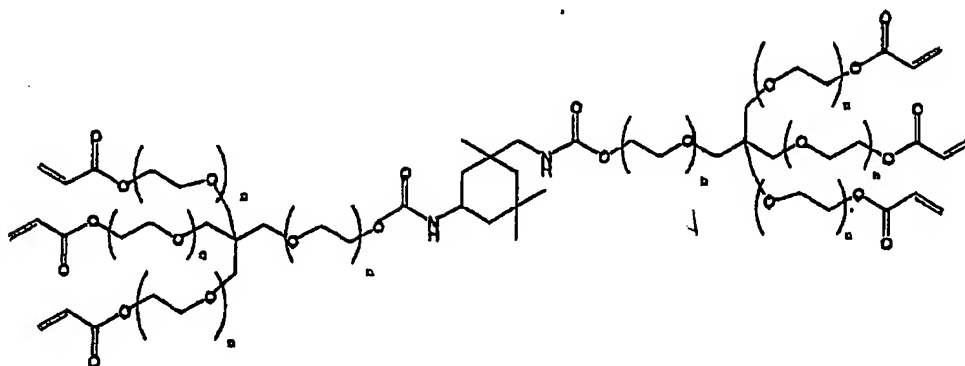
Amendment Under 37 C.F.R. § 1.114(c)

NO. 1902 P. 2

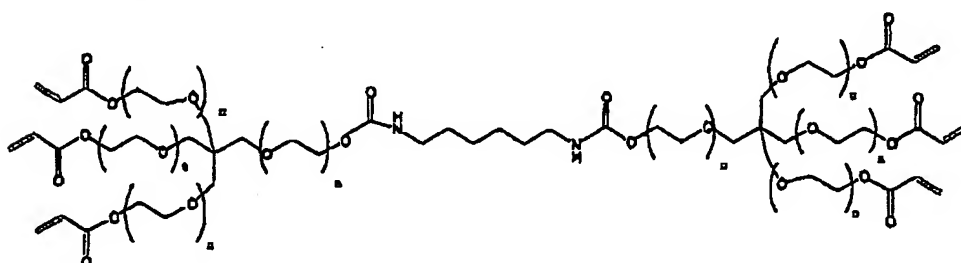
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NKオリゴの主成分の構造

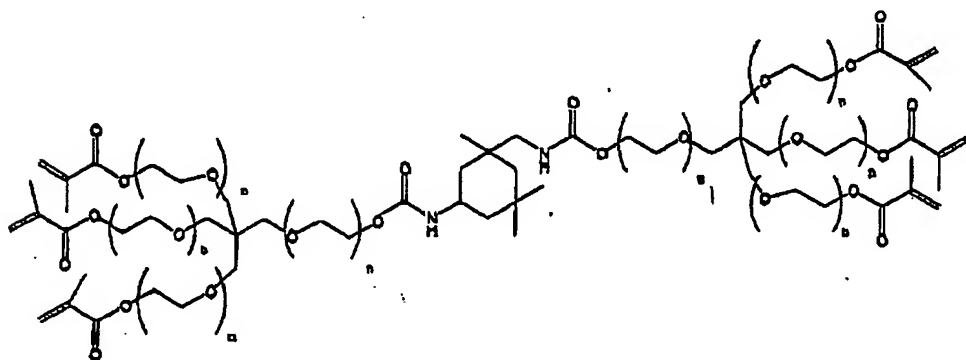
1. UA-6ELP



2. UA-6ELH



3. U-6ELP



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